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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,728	10/19/2001	Yukari Hashizume	550718-093	7391
27805	7590	05/20/2004	EXAMINER	
THOMPSON HINE L.L.P. 2000 COURTHOUSE PLAZA , N.E. 10 WEST SECOND STREET DAYTON, OH 45402			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/037,728	Applicant(s) HASHIZUME, YUKARI	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 17 has been added for further examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynton (6,183,158) in view of Ashcraft et al (6,045,161).

Lynton discloses in Fig. 1, a binder insert comprising: a transparent plastic bag shaped body (10) with an open upper side (56); and a plurality of store portions (Col. 8, lines 55-60) which can store photographs, memos, and "one or more leafs or sheets of paper (store boards),... or the like which may comprises one or more pictures and/or other memorabilia mounted thereon or displayed" (Col. 7, lines 33-40); and a binding section (34) having holes (40).

However, Lynton does not disclose: a pocket placed store board comprising thick paper folded in two and having slits at a predetermined location; a color paper disposed between facing surfaces of the thick paper; slits in various shapes; and slits to hold photograph on an outside surface of the thick paper.

Ashcraft et al discloses in Fig. 1-3, a pocket placed store board (36) comprising thick paper folded in two (42 and 46) having a set of slits (44, slits which form the tabs) at a predetermined location; a color paper (34) disposed between the thick paper surfaces.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lynton's binder insert to include a store board comprising folded thick paper having slits, and a inserted color paper as taught by Ashcraft et al for the

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purpose of mounting indicied substrate(s) in a stable position between the folded store board, so as to prevent movement of the substrate(s).

In regards to **Claim 1 and 17**, it is understood that the process of making store portions can be made by a myriad of processes and that patentability is based solely on the product. Therefore, dividing the portions can be done by any desirable method.

In regards to **Claims 1, 3, 6, 11 and 12**, which discloses a store portion for storing memos; slits being used to insert corner of a photograph and a color paper therebetween; and a color print portion in accordance with the standardized sizes, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the store portion is capable of storing memos; the slits are capable of being used to hold a photograph and a color paper therebetween; and the color prints are capable or providing indication as to the proper slits for various photograph sizes.

In regards to **Claims 4, 5, 7-10, and 13-16**, it would have been an obvious matter of design choice to make the different portions of the slits of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Therefore, it would have been obvious

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to form the slits in any desirable shape, since applicant has not disclosed the criticality of having a particular shape and invention would function equally as well with the slits being in any shape.

In regards to **Claims 10, 16 and 17**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the slits at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the slits in any desirable location required by the end user, since applicant has not disclosed the criticality of having the slits in a particular location and invention would function equally as well with the slits placed at any location since the slits intended use is to hold and secure a substrate.

In regards to **Claims 6 and 12**, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. Therefore, it would be obvious to form the paper with any desirable colored paper can be inserted in the slots. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable amount of substrates to be held by the slits, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include any number of indicied substrates to be held by a set of slits, since applicant has not disclosed the criticality that the slits can only secure a particular number of substrates, and invention would function equally as well with any number of substrates.

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*Response to Arguments*

3. Applicant's arguments filed on February 13, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that neither reference discloses "a memo store portion and a memo paper in the store portion", the examiner submits that the Lynton reference is now used to disclose store portions (pockets) which are capable of storing a variety of items which can include the structure of a "store board". Therefore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the store portion is capable of storing memos.


*Prior Art References*

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Lynton, Holson, and Glazer et al, disclose similar inserts.

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

May 7, 2004



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